

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed May 17, 2005 ("*Final Office Action*"). Applicants cancel Claims 11 and 31 without prejudice or disclaimer. Claims 1-10, 12, 14-30, 32, and 34-105 are pending in the Application and stand rejected. Applicants respectfully request reconsideration and favorable action in this case.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejects Claims 1-12, 14-32, and 34-105 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,711,166, which issued to Amir ("*Amir*"). To anticipate a claim, a single prior art reference must describe, either expressly or inherently, each and every element of the claim. M.P.E.P. § 2131.

Consider Applicants' independent Claim 1, which recites:

A system capable of performing state-based signaling on behalf of a stateless client, comprising:

a controller, couplable to a state-based terminal, that translates at least one stateless signaling message received from said stateless client to at least one state-based signaling message for presentation to said state-based terminal thereby facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.

Applicants respectfully submit that *Amir* fails to describe every element of this claim.

Among other aspects of Claim 1, *Amir* fails to describe "facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal." As teaching the state-based terminal, the Examiner points to the H.323 Terminals shown and described in *Amir*. *Final Office Action*, pages 7-8. As teaching the stateless client, the Examiner points to two alternatives in *Amir*: the IP Terminal in Figures 6A and 6B and the IP Telephone in Figure 7. *Id.* Neither of these two elements are stateless clients.

With respect to the IP Terminal, the text of *Amir* refers to this element only once. The paragraph referencing the IP Terminal states:

As above, the system of this embodiment supports terminals running several different protocol standards. For example, the telephones may support the Integrated Services Digital Network ("ISDN") protocol, they may be standard analog sets or they may support some other protocol (not shown). Again, as described above, the data terminals may be protocol-based. Those depicted are **IP terminals** and H.323 terminals.

Amir, col. 10, lines 31-38 (emphasis added). In this paragraph, *Amir* fails to identify any particular types of IP protocols or operations contemplated for the IP Terminal. Other portions of *Amir* fail to shed any light on any other IP protocols contemplated for the IP Terminal. However, in examining the full disclosure of *Amir*, it becomes evident that *Amir* likely uses the "IP Terminal" element to depict a generic IP terminal (other than an H.323 terminal), with the H.323 terminals depicting the particular type of IP terminal envisioned by *Amir*.

Amir first introduces "protocol-based" data terminals with respect to Figure 2 (which does not include IP Terminals or IP Telephones) and lists H.323, H.324 and H.320 as example protocols. *Amir*, col. 4, lines 48-60. Of these examples, only H.323 refers to an IP-based protocol (H.324 refers to a protocol for analog devices and H.320 to a protocol for ISDN). Thus this text fails to provide any guidance for the IP protocols or operation contemplated for the IP Terminal of Figure 6. Further, no other disclosure in *Amir* provides any guidance for the IP protocols or operation contemplated for the IP Terminal of Figure 6. Therefore, other than labeling the element in Figures 6A and 6B as an IP Terminal, *Amir* provides no information as to the specific protocol or operation of this terminal. *Amir* certainly does not specify that the IP Terminal is stateless, as required by Applicants' Claim 1. If anything, *Amir* appears to treat the IP Terminal as similar to the H.323 Terminal, which the Examiner admits is state-based. Therefore, Applicants respectfully submit that the IP Terminal relied on by the Examiner fails to teach or suggest a stateless client as required by Applicants' Claim 1.

Amir's treatment of the IP Telephone depicted in Figure 7 is similar to that of the IP Terminal. With respect to the IP Telephone, the text of *Amir* refers to this element only once, stating:

A router A 120 receives calls from other networks (e.g., network 124) and several **terminals 122A, 122B and [122C]**.

Amir, col. 11, lines 39-44 (emphasis added). No other text or figures in *Amir* help to shed light on the nature of this IP Telephone. However, even though Figure 7 labels element 122A as "IP Telephone," the reference to this element in the text as terminal 122A perhaps indicates that the "IP Telephone" label is merely a variation of the "IP Terminal" label used in Figure 6. Regardless, *Amir* provides no information as to the specific protocol or operation of this IP Telephone. *Amir* certainly does not specify that the IP Telephone is stateless, as required by Applicants' Claim 1. Moreover, *Amir* treats the IP Telephone as an equal alternative to the H.323 Terminal, which the Examiner admits is state-based. Therefore, Applicants respectfully submit that neither of the elements relied on by the Examiner teach or suggest a stateless client as required by Applicants' Claim 1.

For at least these reasons, Applicants respectfully submit that *Amir* fails to describe, either expressly or inherently, each and every element of independent Claim 1. For analogous reasons, Applicants respectfully submit that *Amir* fails to describe, either expressly or inherently, each and every element of independent Claims 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claims 1, 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99 as well as their respective dependent claims.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 1-12, 14-32, and 34-105 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,726,984, which issued to Kubler, et al. ("*Kubler*"), in view of *Amir*. To establish obviousness of a claimed invention under § 103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. Furthermore, the Examiner must point to some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention either explicitly or implicitly in

the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. *Id.* § 2143.01.

Again, Applicants' independent Claim 1 recites:

A system capable of performing state-based signaling on behalf of a stateless client, comprising:

a controller, couplable to a state-based terminal, that translates at least one stateless signaling message received from said stateless client to at least one state-based signaling message for presentation to said state-based terminal thereby facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.

Applicants respectfully submit that *Kubler* and *Amir*, whether taken alone or in combination, fail to teach or suggest every element of this claim.

Among other aspects of Claim 1, the *Kubler-Amir* combination fails to teach or suggest "facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal." The Examiner admits that *Kubler* fails to teach or suggest this element and instead relies upon *Amir*. *Final Office Action*, at pages 6-7. However, as discussed in detail above, *Amir* fails to teach or suggest these aspects of the claim.

For at least these reasons, Applicants respectfully submit that *Kubler* and *Amir* fail to teach or suggest each and every element of independent Claim 1. For analogous reasons, Applicants respectfully submit that *Kubler* and *Amir* fail to teach or suggest each and every element of independent Claims 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claims 1, 16, 21, 36, 41, 51, 56, 66, 71, 76, 81, 87, 89, 91, and 99 as well as their respective dependent claims.

Furthermore, Applicants respectfully submit that Claims 1-10, 12, 14-30, 32, and 34-105 are patentable over *Kubler* in view of *Amir* because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Kubler* and *Amir* either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. In the *Final Office Action*, the Examiner responded to Applicants' previous objection to this combination, stating:

In this case, Kubler discloses a method and system for exchanging a media between the stateless and state-based client via internet network. Amir discloses a method and system for exchanging media communications session between the stateless and state-based client via internet network wherein the media communication session comprises packets for exchanging between them. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate a stateless and state-based device into IP network for exchanging the information comprising the packets between the stateless and state-based client as disclosed by Amir's system and method into the system and method of Kubler. The motivation would have been to reduce the cost of telephone call.

Final Office Action, page 9.

First, Applicants respectfully submit that this statement mischaracterizes the teachings of the references. As discussed in detail above, *Amir* fails to teach or suggest both stateless and state-based IP elements, yet the Examiner's assertions treat this as part of the rationale for the combination. Second, with respect to the motivation, Applicants respectfully submit that the *Final Office Action* fails to identify how the proposed *Kubler-Amir* combination would reduce the cost of a telephone call or why this would provide the motivation for the combination.

In short, these statements represent the subjective belief of the Examiner, do not point to any known authority, and therefore are not based on objective evidence of record. Thus, the record fails to provide any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For this additional reason, Applicants respectfully submit that Claims 1-10, 12, 14-30, 32, and 34-105 are allowable over the cited references.

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31

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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